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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,259	03/18/2004	Ralph B. Lilly	Anon-001:C	5397
21897 7590 02/22/2008 THE MATTHEWS FIRM 2000 BERING DRIVE SUITE 700 HOUSTON, TX 77057				
EXAMINER NAJARIAN, LENA				
ART UNIT		PAPER NUMBER		
3626				
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02/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,259

Applicant(s)

LILLY ET AL.

Examiner

LENA NAJARIAN

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 12/26/07. Claims 23 and 24 are newly added. Claims 1-4, 6-10, and 22-24 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Cunningham (US 6,859,780 B1).
- (A) Claim 22 has not been amended and is rejected for the same reasons given in the previous Office Action, and incorporated herein.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 6,859,780 B1) in view of Borsand et al. (US 2003/0074225 A1).

(A) Claims 1-4 and 6 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

6. Claims 7-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 6,859,780 B1) in view of Borsand et al. (US 2003/0074225 A1), and further in view of Munoz et al. (US 2002/0052760 A1).

(A) Claims 7-10 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 6,859,780 B1) in view of Edelson et al. (5,737,539).

(A) Referring to claim 23, Cunningham does not disclose wherein the one or more patterns from the prescriptive history would indicate prescription duplication, or multi-source prescription abuse.

Edelson discloses wherein the one or more patterns from the prescriptive history would indicate prescription duplication, or multi-source prescription abuse (col. 27, lines 32-54 of Edelson).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Edelson within Cunningham.

The motivation for doing so would have been to control abuse by refusing to process the prescription (col. 27, lines 32-54 of Edelson).

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 6,859,780 B1) in view of Borsand et al. (US 2003/0074225 A1), and further in view of Edelson et al. (5,737,539).

(A) Referring to claim 24, Cunningham and Borsand do not disclose Cunningham does not disclose wherein the one or more patterns from the prescriptive history would indicate prescription duplication, or multi-source prescription abuse.

Edelson discloses wherein the one or more patterns from the prescriptive history would indicate prescription duplication, or multi-source prescription abuse (col. 27, lines 32-54 of Edelson).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Edelson within Cunningham and Borsand. The motivation for doing so would have been to control abuse by refusing to process the prescription (col. 27, lines 32-54 of Edelson).

Response to Arguments

9. Applicant's arguments filed 12/26/07 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 12/26/07.

(A) Applicant argues that Cunningham does not teach, disclose or even suggest obtaining a prescriptive history of a selected prescriptive medication purchaser.

(B) Applicant argues that Cunningham never discloses, or even suggests, generating a pattern from the prescriptive history. Cunningham does not teach, disclose, or even suggest any means for indicating or determining a possibility of prescription abuse.

(C) Applicant argues that there is no teaching or suggestion to compare a prescriptive history with a new prescriptive medication.

(1) As per the first argument, the Examiner respectfully submits that Cunningham discloses that "prescriber and pharmacy transactions are all monitored and recorded by the central computing station" (see col. 6, lines 53-55 of Cunningham). Furthermore, Cunningham discloses a database for storing data and information communicated to the central computing station (see col. 4, lines 40-44 of Cunningham). The Cunningham system "manages, tracks, and records selected transactions involving the participating prescribers, pharmacies and patients" (see col. 3, lines 4-10 of Cunningham). As such, the broadest reasonable interpretation of "a prescriptive history" would include the recording of prescription transactions disclosed in Cunningham. Moreover, the claim does not specify the extent of the prescriptive history. The claim merely recites a prescriptive history.

(2) As per the second argument, the Examiner respectfully submits that Cunningham discloses that "in order to help combat prescription *fraud*, new systems must be developed that allow prescription drugs to be tracked such that appropriate reporting may be performed about the dispensation of prescription drugs...." (see col. 2, lines 55-59 of Cunningham). In addition, Cunningham's tracking of refills is clearly a way of determining a possibility of prescription abuse. Cunningham teaches that a "patient is precluded from securing additional refills without a new prescription" (see col. 3, lines 53-67 of Cunningham).

(3) As per the third argument, the Examiner respectfully submits that before a prescription is filled in Cunningham, there is a comparison conducted to detect if there are any refills left (see col. 3, lines 54-67 of Cunningham). As such, the Examiner interprets the decremented refills as a form of prescriptive history.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a medical service and prescription management system (US 2003/0050802 A1); and a prescription verification system (US 6,687,676 B1).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571)272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. N./
Examiner, Art Unit 3626
In
2-14-08

/C. Luke Gilligan/
Primary Examiner, Art Unit 3626